

REMARKS

In response to the Office Action mailed August 21, 2003, Applicant respectfully requests reconsideration based on the above claim amendments and the following remarks. Applicant respectfully submits that the claims as presented are in condition for allowance.

Claims 3, 10-15, 18-47, and 51-61 are currently pending, of which claims 15, 26, 40, 42, 44, and 51 are independent. Applicant has amended claim 15 to more clearly recite the features of the present invention.

In the Office Action mailed August 21, 2003, claims 3, 10-15, 18, 21-30, 31, 34, 35, 44, 51, 54, and 56 were rejected under 35 U.S.C. 103(a) as being anticipated by Vass ("Going2 the wireless world – Wireless Web, road navigation technologies converge to get you where you need to be." PC Week, 68, March 20, 2000) ("Vass") in view of CellPoint ("CellPoint and Webraska Join Forces for New, Live Navigation Services Based on GSM Positioning of Cellular Phones," Business Wire, June 29, 2000) ("CellPoint"). Claims 40-43 were rejected under 35 U.S.C. 103(a) as being obvious over Vass. Claims 19, 20, 38, 39, 45-47, 52, 53, 55, 57, and 61 were rejected under 35 U.S.C. 103(a) as being unpatentable over Vass in view of CellPoint. Claims 32, 33, 36, 37, and 58-60 were rejected under 35 U.S.C. 103(a) as being unpatentable over Vass in view of CellPoint. To the extent these rejections might be applied to the currently pending claims, Applicant respectfully traverses the rejections as follows.

Examiners Ouellette and Weiss are thanked for the courtesies extended to Applicant's representatives during the personal interview conducted October 30, 2003. An agreement with respect to the independent claims was not reached because the Examiners discussed that the elements appearing in the independent claims would have been obvious to include with the prior

art – as it would provide not distinct advantage – and furthermore, such (data) elements would be non-functional to the claimed system. During the interview, the Examiners also indicated that *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Feb. Cir. 1983) and *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) supported the rejections.

Applicant respectfully traverses the above rejections based on the reasons below.

Rejection under 35 U.S.C. 103(a)

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P §2143. Without conceding the first and second criteria, Applicant asserts that cited combination do not teach or suggest each and every elements of the claims.

Vass describes a wireless locator site that helps travelers find products and services while they are on the road. According to Vass, a consumer must enter his or her location via a street address. The street address is then translated into an eight-digit number representing the latitude/longitude coordinates. The consumer then inputs the service he or she is seeking by typing in either a generic category or a brand-specific products or service. The wireless locator site then identifies the nearest outlets. In addition, the system according to Vass delivers driving instructions and phone numbers to the consumer. As acknowledged in the Office Action, Vass fails to teach or to suggest “each advertiser entry of at least a second subset of the plurality of advertiser entries lacking advertiser measured location information.”

For the obviousness rejections, the Examiner relied upon CellPoint to combine with Vass. Cellpoint is merely an article news that announces a demonstration for a traffic information and navigation services on Internet mobile phones will be held during the Mobile Location Services and Applications Conference in London on July 6-7. (The second last paragraph of page 1.) The article continues describing, very vaguely, that "conference attendees will be able to witness the time and hassle savings associated with being automatically located on a map and then guided to a destination address or facility such as a restaurant, ATM, petrol station, drugstore, etc."

However, in any combinations of Vass and Cellpoint, there are no teachings or suggestions that a processor is configured to "select one or more advertiser entries of at least one of the first subset and the second subset of the plurality of advertiser entries from the yellow pages database based at least in part on a user advertiser category, organize a listing of the selected one or more advertiser entries based at least in part on the user measured location information and the advertiser measured location information, and present the selected one or more advertiser entries based at least in part on the user measured location information and the advertiser measured location information of the selected one or more advertiser entries," as recited in claims 15, 26, 44 and 51. Furthermore, in any combinations of Vass and Cellpoint, there are not teachings or suggestions that storing advertiser identifiers in at least each advertiser entry of a third subset of the plurality of advertiser entries, wherein the advertiser identifiers in the third subset lacks advertiser measured location information, as recited in claims 44 and 51. Moreover, in Vass, there is absolutely no mention of charging a fee to advertisers as recited in claims 40 and 42.

Accordingly, Applicant respectfully submits that the rejection of all of the pending claims under 35 U.S.C. 103(a) as being unpatentable by either Vass singly or by Vaas in view of CellPoint should be withdrawn.

Interpretation of Cited Case Law

Furthermore, during the personal interview, Examiners Outlette and Weiss indicated that the limitations of the independent claims are non-functional descriptive material and are not functionally involved in the steps recited. The Examiners asserted that the outcome of providing locations to the subscriber shows no differences from the prior art even if the processor organizes and display the one or more advertiser entries in a different way. With regard to the case law cited by the Examiners, Applicant respectfully submits that the case law actually supports the patentability of the claimed invention. Applicant believes that a proper interpretation of the case law would render claims 15, 26, 40, 42, 44, and 51 patentable over the Vass in view of CellPoint.

In *In re. Gulack* 703 F.2d 1381, the court reversed the decision of the U.S. Patent and Trademark Office Board of Appeals regarding the rejection under 35 U.S.C. 103 of claims 1-4 and 6 of application serial No. 935,183 for the reason that “mere presence or absence of a specific functional relationships, without further analysis, is not dispositive of obviousness, but, rather, the critical unobvious functional relationship between the printed matter and the substrate.” (*Id.*) The Court stated that

“a functional relationship does exist between the printed matter and substrate. A functional relationship of the precise type found by the CCPA in *Miller* – to size or to type of substrate, or conveying information about substrate – is not required. What is required is the existence of *differences* between the appealed claims and the prior art sufficient to establish patentability. The bare presence or absence of a specific functional relationship, without further analysis, is not dispositive of obviousness. Rather, the critical question is whether there exists any new and

unobvious functional relationship between the printed matter and the substrate.”
(*Id.* at 1386) (emphasis in original)

In *In re Lowry* 32 F.3d, 1579, the court reversed the decision of the U.S. Patent and Trademark Office Board of Appeals regarding the rejection under 35 U.S.C. 103 of claims 1-19 and under 35 U.S.C. 102 of claims 20-29 of application serial No. 07/181,105. *Lowry* relates to a computer memory data structure comprising a plurality of attribute data objects. The court stated that:

“where inventor’s claims did not claim merely the information content of memory or underlying data in database, but claims dictated how application programs manage information, defined functional characteristics of the computer memory, and required specific electronic structural elements which imparted physical organization on information stored in memory, and where data structures claimed were specific electrical magnetic structural elements in a memory.” (*Id.*)

“Lowry’s claims dictate how application programs manage information. Thus, Lowry’s claims define functional characteristics of the memory.” (*Id.* at 1583)

“The PTO did not establish that the ADOs, within the context of the entire claims, lack a new and nonobvious functional relationship with the memory. The ADOs follow a particular operations on stored data. The ADOs facilitate addition, deletion, and modification of information stored in the memory. In sum, the ADO’s perform a function.” (*Id.* at 1584) (emphasis added)

In the present invention, the systems and methods for providing location-based yellow pages information as claimed in the independent claims involves selection of one or more advertiser entries, organization of the selected one or more advertiser entries, and presentation of the selected one or more advertiser entries. According to *In re Gulack* and *In re Lowry*, the management of data are deemed functional and entitled to patentable weight.

Accordingly, Applicant respectfully submits that independent claims 15, 26, 40, 42, 44, and 51 include patentable subject matter under *In re Gulack* and *In re Lowry*. Applicant further

respectfully submits that prime facie case of obviousness has not been established because none of Vass and CellPoint, whether taken singly or in combination thereof, teaches or suggests the features as recited in independent claims 15, 26, 40, 42, 44, and 51. Dependent claims 3, 10-4, 18-25, 27-39, 41, 43, 49-50 and 51-61 should be patentable at least due to their dependencies from patentable independent claims.

In view of the foregoing, all of the claims in the present application are believed to be in condition for allowance. Should the Examiner have any questions or determine that any further action is desirable to place this application in even better condition for issue, the Examiner is encouraged to telephone applicants' undersigned representative at the number listed below.

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Respectfully submitted,

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